

REMARKS

The Applicants are filing this Amendment and Response in response to an Office Action mailed on November 3, 2006. At the time of the Office Action, claims 1-26 were pending. Claims 4, 5, 11, 12, 18, 19, 25 and 26 are canceled, and no new claims are added herein. Thus, claims 1-3, 6-10, 13- 17 and 20-24 remain pending. By this paper, Applicants have amended claims 1, 8, 15 and 22-24 for clarification of certain features to expedite allowance. Applicants respectfully assert that these amendments do not add any new matter. Reconsideration and allowance of all pending claims is respectfully requested.

In the Office Action, the Examiner objected to the specification of the present application as failing to include a Background of The Invention section, and a Brief Summary of the Invention section. Claims 22-26 were rejected under 35 U.S.C. §112, Second Paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Claims 22-26 were also rejected under 35 U.S.C. §101 being directed to non-statutory subject matter. Claims 1-26 were rejected under 35 U.S.C. § 102 as being anticipated by Dan et al. (U.S. Patent No. 6,560,639, hereinafter “the Dan reference”). Each of those objections and rejections is addressed below.

Objection To The Specification

As set forth above, the Examiner objected to the specification of the present application as failing to include a Brief Summary of the Invention section. Applicants traverse the objection.

The Applicants are not aware of any law or regulation that requires a patent application to contain a Background of the Invention Section and/or a Summary of the Invention section. Specifically, with the regard to the Summary of the Invention section, the most relevant regulation is 37 C.F.R. § 1.73, which states:

A brief summary of the invention indicating its nature and substance, which may include a statement of the object of the invention, *should* precede the detailed description. Such summary should, *when set forth*, be commensurate with the invention as claimed and any object recited should be that of the invention as claimed.

37 C.F.R. § 1.73 (Emphasis added.)

Additionally, 37 C.F.R. § 1.77, which was cited by the Examiner, indicates that the sections of the applications “should” be arranged in a particular order “if applicable.” *See* 37 C.F.R. § 1.77. The failure of the regulations to require a Summary of Invention section is apparent from the plain language of the regulations themselves. The fact that guidance is given for *when* a Summary of the Invention section is set forth clearly indicates that a Summary of the Invention Section is optional, not a requirement. Accordingly, Applicants respectfully request withdrawal of the objection to the specification for failure to include a Summary of the Invention section.

The Examiner further objected to the specification as lacking a section entitled “Background of The Invention.” Although Applicants do not concede the correctness of this objection, Applicants have nonetheless amended the previous heading “Background of the Related Art” to “Background of the Invention” to further

prosecution of the application. The Applicants are aware of no authority for the Examiner's assertion that the Background of the Invention section must include subsections entitled "Field of the Invention" and "Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98." Moreover, the Applicants are not required to include these subsections in the Background of the Invention section. Accordingly, the Applicants respectfully request withdrawal of the objection to the Specification based on the Applicants' failure to include a Background of the Invention Section.

Rejections Under 35 U.S.C. §112

With respect to the rejection of claims 22-24 under Section 112, Second Paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter regarded as the invention, the Examiner stated that "[i]t is not known the meaning of the limitation 'program' in the preamble." While not conceding the correctness of the rejection, Applicants have nonetheless amended claims 22-24 to specifically recite "a tangible machine readable medium" to clarify the claimed subject matter. This claim structure has been affirmatively endorsed by the Federal Circuit. *See In re Beauregard*, 53 F.3d 1583 (Fed. Cir. 1995). Accordingly, Applicants request withdrawal of the rejection of claims 22-24 under Section 112.

Rejections Under 35 U.S.C. § 101

With respect to the Examiner rejection of claims 22-24 under Section 101 as being directed to non-statutory subject matter, the Examiner stated that “[c]laiming a program per se is not statutory as set forth under 35 U.S.C. 101.” Applicants respectfully traverse this rejection.

Legal Precedent

According to the Supreme Court, congress intended statutory subject matter to “include anything under the sun that is made by man.” *Diamond v. Chakrabarty*, 447 U.S. 303, 308-09; 206 U.S.P.Q. 193, 197 (1980). Indeed, exclusions of statutory subject matter are limited to laws of nature, natural phenomena and abstract ideas. *See Diamond v. Diehr*, 450 U.S. 175, 185; 209 U.S.P.Q. 1, 7 (1981). Other than these specific exceptions, therefore, nearly anything man made is statutorily patentable subject matter under 35 U.S.C. §101.

In determining when process or method claims include statutory subject matter, the Supreme Court in *Diehr* stated that “[t]ransformation and reduction of an article ‘to a different state or thing’ is the clue to the patentability of a process claim that does not include particular machines.” *See id.* 450 U.S. at 183-185, 209 U.S.P.Q. at 6. In addition to the Supreme Court’s transformation and reduction test, the Federal Circuit has developed a second test which may also be used to determine if a claim recites statutory subject matter, namely does the claim produce a “useful, concrete, and tangible result.” *In re Alappat*, 31 U.S.P.Q.2d 1545, 1557 (Fed. Cir. 1994) (*en*

banc). The Federal Circuit further elaborated on this second test by holding that one must look to “the essential characteristics of the subject matter, in particular, its practical utility.” *State Street Bank & Trust Co. v. Signature Financial Group Inc.*, 47 U.S.P.Q.2d 1596, 1602 (Fed. Cir. 1998).

However, explaining this “useful, concrete, and tangible” test, the Federal Circuit has stated “the dispositive inquiry is whether the claim *as a whole* is directed to statutory subject matter.” *In re Alappat*, 31 U.S.P.Q.2d at 1557. Indeed, there has been no requirement from Congress, the Supreme Court, or the Federal Circuit mandating that a *specific final result* be shown for a claim to qualify under Section 101. *See id.* Rather, the Federal Circuit has specifically stated “the *Alappat* inquiry simply requires an examination of the contested claims to see if the claimed subject matter *as a whole* is a disembodied mathematical concept representing nothing more than a ‘law of nature’ or an ‘abstract idea,’ or if the mathematical concept has been reduced to *some practical application rendering it ‘useful’*.” *AT&T Corp. v. Excel Communications, Inc.*, 50 U.S.P.Q.2d 1447, 1451 (Fed. Cir. 1999) (emphasis added). Therefore, if a claim meets either the transformation and reduction test put forth by the Supreme Court, or if the claim, read as a whole and in light of the specification, produces any useful, concrete, and tangible result, the claim meets the statutory requirements of Section 101. *See id.*

Applicants respectfully assert that claims 22-24, taken as a whole, each recite statutory subject matter under 35 U.S.C. §101 because they produce a useful, concrete and tangible result. The present Application is directed to methods and systems for

easily enabling changing appearance or look and feel of c-frames for different users or groups of users. Particularly, the present application is aimed at providing a system configured to alleviate problems associated with existing web applications in which:

it may be difficult to change the appearance or look and feel of the c-frame for different users or groups of users. Time consuming code changes in the actual content pages may be required to separate page content from the navigational look and feel of the pages.

Application, paragraph 4.

For example, independent claim 22 recites *a tangible machine readable medium* comprising code for creating a controller generator stored on the machine readable medium, and code for creating a layout manager generator stored on the machine readable medium.” (Emphasis added.) Further, the layout manager generator is adapted to provide “a layout manager that formats a c-frame based on configuration information and renders the c-frame as part of the information sent to the user in response to the request, wherein the configuration information corresponds to a plurality of portals, and wherein the layout manager is adapted to produce a different c-frame in response to requests received via each of the plurality of portals.”

Claim 22, therefore, taken as a whole, recites code stored on a tangible readable medium that enables users, via a plurality of portals, to request configuration information of c-frame formats for each of the plurality of portals. In so doing, different user group can more easily change appearance or look and feel of c-frames corresponding to the plurality of portals used by the users to send requests for the

configuration information. This could be achieved, for example, by reducing and/or eliminating time consuming code changes implemented in actual content pages needed to separate page content from the navigational look and feel of the pages. This is clearly a useful, concrete and tangible result which addresses the above mentioned shortcomings of existing web applications. Accordingly, Applicants respectfully request withdrawal of the rejection of claims 22-24 under Section 101.

Claim Rejection Under 35 U.S.C. § 102

With respect to the rejection of claims 1-26 under Section 102(b) as being anticipated by the Dan reference, the rejections of independent claims 1, 8, 15 and 22 are exemplary:

As per Claim 1: Dan discloses, A system
(See FIG.2), comprising:

a controller generator that is adapted to provide an application with a controller that receives a request for data from a user and responds to the request by sending information to the user in a predetermined format (See FIG. 3-4);

and a layout manager generator that is adapted to provide a layout manager that formats a c-frame based on configuration information and renders the c-frame (e.g. all the dots in the section Admin, For example, see FIG. 7; the designed selections of this configuration information from Web designers will render the layout C-frame of FIG. 13) as part of the information sent to the user in response to the request (See the Admin provided in FIG. 9 etc.).

As per Claims 8-14, and 15-21: Dan discloses the claimed limitation as addressed in the same reason as in Claims 1-7 above, respectively.

As per Claims 22-26: Dan discloses the claimed limitation as addressed in the same reason as in Claims 1-5 above, respectively.

Office Action, pp. 4-5

Legal Precedent

The Applicants respectfully traverse the rejection. Anticipation under section 102 can be found only if a single reference shows exactly what is claimed. *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 227 U.S.P.Q. 773 (Fed. Cir. 1985). For a prior art reference to anticipate under section 102, every element of the claimed invention must be identically shown in a single reference. *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). In order to maintain a proper rejection under section 102, a single reference must teach each and every element or step of the rejected claim, else the reference falls under section 103. *Atlas Powder v. E.I. du Pont*, 750 F.2d 1569 (Fed. Cir. 1984). Accordingly, the Applicants need only point to a single element not found in the cited reference to demonstrate that the cited reference fails to anticipate the claimed subject matter. The prior art reference also must show the *identical* invention “*in as complete detail as contained in the ... claim*” to support a *prima facie* case of anticipation. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q. 2d 1913, 1920 (Fed. Cir. 1989).

First, Applicants respectfully note that this case involves rather complex subject matter. Given the complex nature of the technology, the level of detail contained in the rejection of the claims under Section 102 appears to be superficial

and vague. In accordance with 37 C.F.R. § 1.104(e)(2), the Examiner is reminded that:

[i]n rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.

37 C.F.R. § 1.104(e)(2).

In spite of the vagueness of the rejection, Applicants have responded below to the rejection based on the Dan reference to the extent understood from the assertions set forth by the Examiner.

The rejection of independent claims 1, 8, 15 and 22 under Section 102 as being anticipated by the Dan reference is improper because the Dan reference does not show each and every element recited by the claims. Independent claims 1, 8, 15 and 22 recite methods and systems having a controller generator for providing an application with a controller that receives requests for data from users. The above claims further recite a layout manager generator for providing a layout manager that formats a c-frame based on configuration information, “wherein the configuration information corresponds to *a plurality of portals*, and wherein the layout manager is adapted to produce *a different c-frame* in response to requests received *via each of the plurality of portals*.” (Emphasis added.)

In contrast, the Dan reference clearly fails to disclose the recited subject matter of independent claims 1, 8, 15 and 22. First, Applicants note that the Dan reference simply does not disclose a plurality of portals. Moreover, the Dan reference does not even contain a single occurrence of the word “portal.” In the Office Action, the Examiner interpreted web pages disclosed in the Dan reference as the claimed plurality of portals. Specifically, the Examiner stated “HTML code per se that provides to connection to a service.” Office Action, page 5. Notwithstanding the lack of clarity and relevance provided by the aforementioned assertion, Applicants respectfully submit that a portal may be described as:

[a] web site that serves as a gateway to the Internet. A portal is a collection of links, content, and services designed to guide *users* to information they are likely to find interesting.
Microsoft Computer Dictionary, Fifth Edition,
page 413. (Emphasis added.)

On the other had, a web page is defined as:

[a] document on the World Wide Web. A web consists of an HTML file, with associated files for graphics and script, in particular directory on a particular *machine*.
Microsoft Computer Dictionary, Fifth Edition,
page 564. (Emphasis added.)

Hence, being associated with a particular machine, the scope of utility and applications provided by a web page may be far less than those provided by a web portal, as the latter is more accessible to and, thus, more employable by multiple users.

Next, because the Dan reference fails to disclose the plurality of portals, the Dan reference cannot disclose the claimed configuration information corresponding to a plurality of portals, wherein the layout manager is adapted to produce a different c-frame in response to requests received via *each* of the plurality of portals. The Examiner's assertion that "HTML code per se that provides to connection to a service" (Office Action, p. 5) somehow equates with the claimed plurality of portals is without any support whatsoever in the Dan reference. Rather, the Examiner has essentially taken Official Notice of facts outside of the record that the Examiner apparently believes are capable of demonstration as being "well-known" in the art. Therefore, in accordance with M.P.E.P. § 2144.03, the Applicants hereby traverse and challenge the Examiner's use of Official Notice. Furthermore, Applicants emphasize that the "well-known" facts asserted by the Examiner are not of a "notorious character" and are clearly not "capable of such instant and unquestionable demonstration as to defy dispute." See M.P.E.P § 2144.03. Specifically, Applicants respectfully assert that the use of a plurality of portals as recited in the claims is not common knowledge within the art. Applicants respectfully request that the Examiner produce evidence in support of the Examiner's position as soon as practicable during prosecution and that the Examiner add a reference to the rejection in the next Office Action.

Hence, no plurality of portals is taught in Dan, much less a layout manager adapted to produce a *different* c-frame in response to requests received via each of the plurality of portals manger. Therefore, the Dan reference does anticipate independent claims 1, 8, 15 and 22, as well as those claims dependent thereon. Withdrawal of the

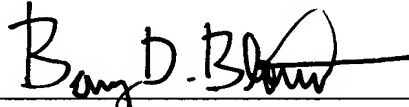
rejection of those claims and the claims dependent thereon under Section 102 is respectfully requested.

Conclusion

Applicants respectfully submit that all pending claims are in condition for allowance. However, if the Examiner wishes to resolve any other issues by way of a telephone conference, the Examiner is kindly invited to contact the undersigned attorney at the telephone number indicated below.

Respectfully submitted,

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